

REMARKS

Upon entry of the present amendment, the claims in the application are amended claims 19-34, with independent claims 19 and 27 and dependent claims 20 and 28 being amended by the present amendment.

Applicant respectfully traverses the objection under 35 USC 132(a).

Attention is respectfully directed to the following portions of the patent application as originally filed:

Page 2, lines 7-8, state “the elastic base member is made solid in the direction of thickness thereof and consists of one layer or two layers integrally connected therebetween,”;

claim 1 states “characterized in that the elastic base member is made solid in the direction of thickness thereof and consists of one layer or two layers integrally connected therebetween”; and

the Abstract states “The novel feature of the applicator consists in that the elastic base member (1) is made solid in the direction of its thickness and consists of one layer or two layers integrally connected therebetween,”.

With regard to the amended language effected in claims 19, 20, 27 and 28 by the present amendment, applicant respectfully directs attention to the portions enumerated above of the patent application as originally filed, and the following additional portions of the patent application as originally filed:

The sentence bridging pages 1 and 2 states “The main object of the present invention consists in improving the applicator by way of clamping the needles in the base member which is made solid in the direction of thickness thereof, thereby providing rigid fixation of needles in the

applicator base member and ensuring stability of needles position under any conditions of applicator use, as well as increasing elasticity of the base member.”;

page 2, lines 11-19 state “The needles are mounted in the base member with thickened portions (heads) thereof while said base member is in plasticized condition; here, the base material brought to the state of fluidity completely envelops the surface of each needle and tightly clamps said surface during the process of base material curing, i.e. in formation of a solid base member, thereby ensuring rigid fixation of needles in the base member and eliminating the possibility of either their deepening into the base or protruding therefrom or tilting about axes thereof; at the same time such fixation of needles in the base member does not cause any decrease in the applicator flexibility.”;

page 9, lines 1-4 state “In one embodiment of the invention, surface 5 of base member 1 is provided with lugs 6 (Fig. 2) that envelop needles 2. Lugs 6 increase the length, L, of clamping needles 2 in base member 1, thereby improving stability of their position and limiting the deepening of needles into user’s epidermis.”;

page 10, lines 5-8 state “Needles 2 that are tightly clamped in base member 1 of the applicator keep their position, i.e. do not either deepen into base member 1 or protrude therefrom during any bends of the base member 1 and pressures acting on the applicator.”;

page 2, lines 31-33 which state “The needles can be made tapered in the direction from thickened portion toward the sharpened portion thereof, thereby increasing the stability of their position, particularly in the direction perpendicular to the base member surface,”;

page 3, lines 7-8 which state “The base member of the applicator may be made in the form of a rectangular plate.”;

page 6, lines 23-24 which state “Fig. 2 shows a fragment of the inventive applicator

wherein protrusions on the base member envelop needle stems;”

page 7, lines 1-2 which state “Fig. 6 shows a device for making the inventive applicator in the form of a plate;”

claim 6 which states “An applicator as defined in any one of claims 1 through 5, characterized in that the base member is made in the form of a rectangular plate.”; and

Figs 1-6.

CLAIM REJECTIONS – 35 USC SECTION 103

Applicant respectfully traverses the 35 USC 103 rejection of previous claims 19, 21, 23, 27, 29 and 31 as being unpatentable over Gelfer et al. in view of Leupold, especially in view of the amendments to the claims effected by the present amendment.

The last OA concedes that Gelfer does not disclose the thickened end of the needle being embedded inside of the base member.

The last OA contends that Leupold teaches that a needle 8 may be embedded in a base material (see fig. 3).

Applicant respectfully traverses this.

In contrast, applicant respectfully submits Leupold element 8 is not a needle, and also does not have a sharpened end. Leupold element 8 is “a pre-shaped part 8” (Leupold, col. 3, line 9), and has “a dull or rounded point” (Leupold, col. 4, lines 12-13, 18).

Furthermore, applicant respectfully submits that Leupold pre-shaped part 8 having a dull or rounded point protrudes from Leupold ~~recess~~ recess or depression 5, and does not protrude from a major planar surface of an elastic rectangular plate base member, as required by applicant’s amended claims.

With regard to previous claims 27, 29 and 31, the last OA concedes that Gelfer as modified by Leupold does not disclose the two layers.

In addition, applicant respectfully submits that Gelfer as modified by Leupold does not teach or make obvious the features recited in applicant's amended claims.

Applicant respectfully traverses the 35 USC 103(a) rejection of previous claims 20, 22, 24-26, 28, 30, and 32-24 as being unpatentable under Gelfer et al in view of Leupold and further in view of Yoneda et al, especially in light of the amendments to claims 19 and 27 effected by the present amendment, and from which the rejected claims depend.

The distinctions and arguments set forth hereinabove are incorporated hereto by reference thereto.

The last OA concedes that the device of Gelfer et al as modified by Leupold does not disclose lugs surrounding the needles and being disposed on the base member.

Applicant respectfully submits that the deficiency of the combination of Gelfer and Leupold is not supplied by Yoneda, because Yoneda does not disclose "lugs surrounding, contacting and enveloping stems of said needles" as now set forth in amended claims 20 and 28.

With regard to all of the 35 USC 103 rejections, applicant respectfully submits that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916F.2d 680, 16 USPQ2d 1430 (Fed Cir 1990); *In re Fritch*, 972F.2d 1260, 23 USPQ2d 1780 (Fed Cir 1992).

Applicant also respectfully submits that a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill in the art at the time the claimed invention was made because the references relied upon teach that all aspects of the

claimed invention were individually known in the art is not sufficient to establish a *prime facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 1993); *In re. Kotzab* 217 F.3d 1365, 1471, 55 USPQ2d 1313, 1318 (Fed Cir 2000). See also *Al-Site Corp. v. VSI International, Inc.*, 174F.3d 1308, 50 USPQ2d 1161 (Fed Cir 1999), holding that the level of skill in the art cannot be relied upon to provide the suggestion to combine references.

It is also respectfully submitted that Gelfer Figs. 5 and 6 do not disclose needles, as required by applicant's claims. In contrast, Gelfer discloses an elongated bar 19, the cross-section of which happens to be triangular. Nevertheless, it is clear that the Gelfer elongated bar 19 is not a needle.

This deficiency in Gelfer is not supplied by Leopold, as indicated hereinabove. Leopold also does not disclose a needle with a sharpened end, as required in applicant's claims. In contrast, Leopold discloses a pre-shaped part 8 which is not a needle, and which has a dull or rounded point.

In light of the foregoing, applicant respectfully requests reconsideration of the 35 USC 103 rejections, especially in view of the claims as now amended.

It is respectfully submitted that the application is in condition for allowance, and a notice to this effect is earnestly solicited.

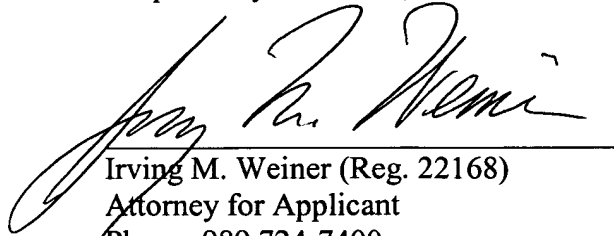
If the Examiner is not convinced that the application is now in condition for allowance, then it is respectfully requested that the Examiner promptly telephone the undersigned attorney for applicant in an effort to facilitate the prosecution, and/or to narrow the issues for appeal, if necessary.

Favorable reconsideration is respectfully requested.

Respectfully submitted,

September

Date: ~~August~~ 7, 2005
Weiner & Burt, P.C.
635 N. US-23
POB 186
Harrisville, MI 48740

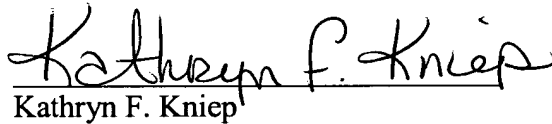


Irving M. Weiner (Reg. 22168)
Attorney for Applicant
Phone: 989 724-7400
Fax: 989 724-7100

Certificate of Mailing

I hereby certify that the foregoing Amendment-D was sent by first class mail to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313-1450 on ~~August~~ 7, 2005.

September


Kathryn F. Kniep